

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: **Philyaw et al.**

Application Serial No.: **09/382,374** **Confirmation No.: 5135**

Filing Date: **August 24, 1999**

Group: **3622**

Examiner: **Arthur D. Duran**

Title: **METHOD AND APPARATUS FOR ALLOWING A
BROADCAST TO REMOTELY CONTROL A COMPUTER**

APPELLANTS' REPLY BRIEF

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This Reply Brief is submitted in accordance with 37 C.F.R. § 41.41 concerning the Examiner's Answer mailed October 18, 2007 in response to the Appellants' Brief on Appeal dated August 3, 2007, that was filed concerning the Notice of Appeal filed January 2, 2007 in response to the Examiner's Final Office Action, dated July 3, 2006, wherein the Examiner finally rejected claims 1-7 and 9-14 that comprise all of the pending claims in this application.

I. Status of the Claims.

Claims 1-7 and 9-14 from the application are pending, stand firmly rejected, and are on appeal here.

II. Grounds of Rejection to be Reviewed on Appeal.

Claims 1, 5, 7, 9-11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,708,478 to Tognazzini (“*Tognazzini*”) in view of U.S. Patent No. 6,029,045 to Picco (“*Picco*”) and further in view of U.S. Patent No. 5,887,243 to Harvey (“*Harvey*”). Claims 2, 3, 4, 6, 12, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,708,478 to Tognazzini (“*Tognazzini*”) in view of U.S. Patent No. 6,029,045 to Picco (“*Picco*”), further in view of U.S. Patent No. 5,887,243 to Harvey (“*Harvey*”), and further in view of U.S. Patent 5,133,011 to McKiel (“*McKiel*”).

The application of the combination of the *Tognazzini*, *Picco* and *Harvey* references to Claims 1, 5, 7, 9-11 and 13 is improper. Further, the application of the combination of the *Tognazzini*, *Picco*, *Harvey*, and *McKiel* references to Claims 2, 3, 4, 6, 12, 14 is improper. The §103 rejections based on these combinations are without basis, and that, despite Appellant’s repeated requests, no *prima facie* case as to either combination constituting a viable combination of references under 35 U.S.C. § 103 has been established.

III. Argument and Discussion.

A *prima facie* case of obviousness requires three basic criteria to be met:

1. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
2. Second, there must be a reasonable expectation of success.
3. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The burden of establishing such a case lies with the Examiner. If the Examiner does not meet each and every criteria required for establishing a *prima facie* case of obviousness, then the rejection based on obviousness is improper, and the applicant is under no obligation to submit evidence of non-obviousness.

In the present application, the various combinations of references proposed by the Examiner are not supported by a proper suggestion or motivation to make each proposed modification. Thus, the first criterion for a *prima facie* rejection has not been met. Further, certain claim limitations are not taught or suggested by the cited combinations, which means that the third criterion for a *prima facie* rejection has not been met. The Examiner has further failed to carry the burden of establishing a *prima facie* rejection for these reasons.

The Examiner addressed this failure of establishing a *prima facie* case of obviousness in his answer, wherein he states:

On page 42, Appellant presents arguments concerning motivation to combine the prior art references.

Examiner notes that rigid preventative rules that deny factfinders recourse to common sense are neither necessary under our case law nor consistent with it. KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007). Also, KSR forecloses the argument that a specific teaching, suggestion, or motivation is require (*sic*) to support a finding of obviousness. See the Board decision *Exparte Smith*, -- USPQ2d --, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396). Also, KSR states that it is obvious to recite combination which

only unite (*sic*) old elements with no change in their respective functions and which yield predictable results. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Also, Tognazzini, Picco, and Harvey are analogous art. Tognazzini discloses live, realtime broadcasts of content and advertising (col 1, lines 5-57). Picco further discloses live, realtime broadcasts of content and advertising (Figure 1 and the Response to Arguments above). And, Harvey discloses live, real-time broadcasts of content and advertising along with control information related to broadcast information (Response to Arguments above). Hence, the combination of the prior art presents obvious features for improving upon the delivery of live, real-time broadcasts of content and advertising with greater control over advertising.¹

Although, in *KSR International Col. v. Teleflex Inc., et al.*, 127 S. Ct. 1727 (2007), the Supreme Court held the Federal Circuit's Teaching, Suggestion or Motivation (TSM) test to combine known elements in order to show that the combination is obvious should not be applied in a rigid manner, the TSM test still is considered to be a factor. *KSR* did not change the fundamental principals of obviousness under U.S. Patent Law. Therefore, merely ignoring Appellant's arguments regarding the TSM test is not sufficient.

Further, the Examiner's application of the findings of *KSR* and the PTO's Examiner's Guidelines directed thereto is deficient as the Examiner has failed to provide any arguments and/or any articulated reasoning as to how any deficiency (missing element) could be solved in a predictable manner through combination with any other reference, as detailed below.

A. Recent Decisions Affecting a Finding of Obviousness.

1. KSR

In the facts of this case, *KSR* owned a patent claiming technology relating to a position sensor for an automobile pedal. Teleflex sued *KSR* for infringement. The district court invalidated the Teleflex patent, citing several prior art references teaching adjustable pedals and sensors. The Supreme Court, in a unanimous opinion, concluded that the district court correctly determined that the Teleflex patent was invalid for obviousness. The Court ruled that a person of

¹ See Examiner's Answer mailed October 18, 2007, page 22.

ordinary skill in the art would have found it obvious to place a sensor on a fixed pivot point of an adjustable pedal, as taught by a combination of the prior art.

The Court reinforced their position that analysis under *Graham* has been reaffirmed. The Court stated that a “patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.”² The Court provided this as a “principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”³ Further, the Court provided three cases that illustrated the application of this doctrine of predictability. The first case was *United States v. Adams*, 383 U.S. 39, 40 (1966). In discussing this case, the Court noted that it had “relied upon the corollary principal that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”⁴ In the second case, *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), the Court reiterated “while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented.”⁵ In the third case, *Sakraida v. AGPro, Inc.*, 425 U.S. 273 (1976), the Court stated that “when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.”⁶

The Court summarized these three cases as follows:

The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. *If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.* For the same reason, if a technique has been used to improve one device, and a person of

²KSR, 127 S. Ct. 1727, 1739 (2007), Citing *Great Atlantic & Pacific Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950).)

³*Id.*)

⁴*Id.* at page 1740)

⁵*Id.*)

⁶ KSR, 127 S. Ct. at page 1740, Citing *Sakraida* at 282.

ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative-a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.⁷ (*emphasis added*).⁸

The Court recognized that following the above-stated principals might involve more than “the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.”⁹ The Court noted that it might “be necessary for a Court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent that issued.”¹⁰ However, the Court also noted that the analysis should be “made explicit” citing *In re Kahn*, 441 F.3d 977, 985 (Fed. Cir. 2006) wherein it stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reason with some rational underpinning to support the legal conclusion of obviousness.”¹¹ The Court noted that “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”¹²

Although the Court in *KSR* appears to reject the rigidity of the TSM test, some reference to the decision in *Alza Corporation v. Mylan Laboratories, Inc.*, 464 F.3d 1286 (Fed. Cir. 2006) was made wherein the Court noted the Federal Circuit’s position that “there is flexibility in our obviousness jurisprudence because the motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine . . . ,” citing *Alza*, 464 F.3d at 1291.¹³ However, the Court also noted that the *Alza* decision was not before it and that, although

⁷ *Id.*

⁸ *Id.*

⁹ *Id.*

¹⁰ *Id.* at page 1741

¹¹ *Id.*

¹² *KSR*, 127 S. Ct. at page 1741.

¹³ *Id.* at page 1743

they may describe an analysis more consistent with the Court's earlier precedence, the Court of Appeals would have to consider the current decision in view of its future cases.

2. Examiner Guidelines

Following the *KSR* decision, the USPTO put forth two notifications regarding the impact of *KSR* on obviousness. The first notification, a memorandum issued on May 3, 2007¹⁴, stated that though the Court had rejected rigid application of the Teaching Suggestion Motivation (TSM) test, the Court did not reject the use of the TSM test as a factor in obviousness analysis. Ultimately, the memorandum pointed out that "[t]he Court noted that the analysis supporting a rejection under 35 U.S.C § 103(a) should be made explicit."¹⁵

The second notification was the publication in the Federal Register of new Examination Guidelines (Guidelines) detailing the procedures to which Examiners should adhere when rejecting a claim based on obviousness. The Guidelines state "[t]o the extent that earlier guidance from the Office, including certain sections of the current Manual of Patent Examining Procedure (MPEP), is inconsistent with the guidance set forth herein, Office personnel are to follow these guidelines."¹⁶ The Guidelines further state that every obviousness rejection must include each of [the Graham] factors laid out by the Examiner.¹⁷ However, once the factors have been laid out by the Examiner, the Examiner must further explain the rationale as to how he came to the conclusion of obviousness.¹⁸ Additionally, the Guidelines reemphasized the statements made in *KSR* and the memorandum, stating "the analysis supporting a rejection under 35 U.S.C § 103(a) should be made explicit."¹⁹

Although not an all-inclusive list, the Guidelines set forth the Rationales to support an obviousness rejection.²⁰ The Rationales include:

¹⁴ United States Patent and Trademark Office Memorandum to Technology Center Directors regarding Supreme Court Decision on *KSR Int'l. Co. v. Teleflex, Inc.*, dated May 3, 2007.

¹⁵ *Id.* at 2.

¹⁶ Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of Supreme Court Decision in *KSR Int'l. Co. v. Teleflex, Inc.*" Federal Register 72 (10 Oct. 2002) 57526.

¹⁷ *Id.* at 57526

¹⁸ *Id.* at 57528

¹⁹ *Id.* at 57528

²⁰ *Id.*

- combining prior art elements according to known methods to yield predictable results;
- simple substitution of one known element for another to obtain predictable results;
- use of known technique to improve similar devices (methods, or products) in the same way;
- choosing from a finite number of identified, predictable solutions, within reasonable expectation of success (i.e., obvious to try);
- known work in field of endeavor may prompt variation of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrived at the claimed invention.²¹

B. 35 U.S.C § 103 Rejection in the Application on Appeal.

In the Examiner's Answer dated October 18, 2007, the Examiner stated:

On page 42, Appellant presents arguments concerning motivation to combine the prior art references.

Examiner notes that rigid preventative rules that deny factfinders recourse to common sense are neither necessary under our case law nor consistent with it. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). Also, KSR forecloses the argument that a specific teaching, suggestion, or motivation is require (*sic*) to support a finding of obviousness. See the Board decision *Exparte Smith*, -- USPQ2d --, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396). Also, KSR states that it is obvious to recite combination which only unite (*sic*) old elements with no change in their respective functions and which yield predictable results. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Also, Tognazzini, Picco, and Harvey are analogous art. Tognazzini discloses live, realtime broadcasts of content and advertising (col 1, lines 5-57). Picco further discloses live, realtime broadcasts of content and advertising (Figure 1 and the Response to Arguments above). And, Harvey discloses live, real-time broadcasts of content and advertising along with control information related to broadcast information (Response to

²¹ *Id.* at 57529

Arguments above). Hence, the combination of the prior art presents obvious features for improving upon the delivery of live, real-time broadcasts of content and advertising with greater control over advertising.²²

Although the Examiner has not introduced a new ground of rejection, he has now provided the *KSR* ruling to support the 35 U.S.C. § 103 rejection. As such, further discussion is required. Under *KSR*, the Examiner is required first to make the analysis explicit. Second, the Examiner is required to provide a rationale to support a conclusion of obviousness. Despite repeated requests, no explicit analysis has been provided, and no articulated reasoning, with some rational underpinning, to support the conclusion of obviousness has been provided. Therefore, a conclusion of obviousness is improper. As such, the Examiner's combination is merely conclusory.

1. Independent Claim 1 as rejected by the combination of *Tognazzini, Picco, and Harvey*.

In the Examiner's Answer mailed October 18, 2007, the Examiner maintains his 35 U.S.C. § 103 rejection of Claims 1-7 and 9-14 as stated on page 11:

Examiner notes that the combination of the prior art renders obvious the features of the Appellant's independent claim 1.

In reference to independent claim 1, the combination of the prior art renders obvious:

a computer having an audio input interface and a display (Tognazzini, Figure 1, 3,6);

an audio output acoustically coupled from a broadcast receiver of a broadcast source to said audio input interface for providing an audio signal having encoded therein advertisement information that is comprised of both advertising content and control information Tognazzini, col3, lines 39-47, Abstract first sentence);

a computer program operable on said computer and responsive to said audio signal output

from said receiver of said broadcast source to allow said computer program to be controlled by the received control information for output of the advertising content, said program comprising:

²² See Examiner's Answer mailed October 18, 2007, page 22.

a program for accessing the advertising information coupled from said receiver of said

broadcast source (Tognazzini, col 1, line 5-57),

a decoder for decoding the received advertising information encoded in said audio signal to provide decoded advertising content and decoded control information, and

means for launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information (Picco, Figures 1,3,4, 5; Harvey, Claim 37; col 197, lines 55-60; col 179, lines 15-39).²³

Appellants' Appeal Brief, filed August 3, 2007, stated that Independent Claim 1 recites "a computer having an audio input interface and a display; an audio output acoustically coupled from a broadcast receiver of a broadcast source to said audio input interface for providing an audio signal having encoded therein advertisement information that is comprised of both advertising content and control information; a computer program operable on said computer and responsive to said audio signal output from said receiver of said broadcast source to allow said computer program to be controlled by the received control information for output of the advertising content, said program comprising: a program for accessing the advertising information coupled from said receiver of said broadcast source, a decoder for decoding the received advertising information encoded in said audio signal to provide decoded advertising content and decoded control information, and means for launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information."²⁴ The Examiner states that "the preceding is obvious in light of the rejection above."²⁵ Appellants have argued, and continue to argue, that independent Claim 1 is not obvious in light of the rejection.

First, Appellants argued that the prior art does not teach "acoustical coupling". In response, the Examiner contends "that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art ... [and] ... that the case history indicates that the acoustical coupling arguments were long ago settled."²⁶ However, throughout the case history,

²³ See Examiner's Answer, mailed October 18, 2007, pages 11-12.

²⁴ See Appeal Brief, filed August 3, 2007, Claims Appendix, Independent Claim 1.

²⁵ See Examiner's Answer, mailed October 18, 2007, page 12.

²⁶ See Examiner's Answer, mailed October 18, 2007, pages 12 and 13.

Appellants never disavowed this element of Independent Claim 1. An applicant's silence regarding statements made by an examiner during prosecution, without more, cannot amount to a "clear and unmistakable disavowal" of claim scope.²⁷ Appellants' have maintained that Independent Claim 1 is allowable as written. Thus, the acoustical coupling arguments were not settled.

The Examiner cites *Tognazzini* to teach an "acoustical coupling." However, *Tognazzini* contains no disclosure for an *audio output acoustically coupled* from a broadcast receiver of a broadcast source to said audio input interface *for providing an audio signal*. The claim requires an audio output that is acoustically coupled to an audio input. Further, the claim requires the audio signal to be provided by this audio output. Clearly, the claim requires the audio signal to be transmitted acoustically, i.e., by methods relating to the sense of hearing. The portion of the specification of the instant application that supports this element of the claim states:

On the receive side of the system, a conventional receiver 110, such as a television is provided. This television *provides a speaker output which provides the user with an audible signal*. This is typically associated with the program. However, the receiver 110 in the disclosed embodiment, also provides an audio output jack, this being the type RCA jack. This jack is utilized to provide an audio output signal on a line 113 which is represented by an audio signal 111. This line 113 provides all of the audio that is received over the communication link 108 to the PC 112 in the audio input port on the PC 112. However, it should be understood that, although a direct connection is illustrated from the receiver 110 to the PC 112, there actually could be a microphone pickup at the PC 112 which could pick the audio signal up. In the disclosed embodiment *the audio signal generated by the advertiser data input device 100 is audible to the human ear and, therefore, can be heard by the user*. Therefore, no special filters are needed to provide this audio to the PC 112.²⁸ (*emphasis added*)

²⁷ See *3M Innovative Props.*, 350 F.3d 1365, 1373-1374 (Fed. Cir. 2003) stating "3M never responded to this statement during the remainder of the prosecution because the objection was overcome without any need to address whether claim 1 was or was not a product-by-process claim. In this context, the examiner's statement does not constitute a clear and unmistakable surrender of claim scope."

²⁸ See Specification page 11, line 20 – page 12, line 6.

Clearly, when read in light of the specification, the audio signal must be a signal that is capable of being heard as defined by the fact that the claim requires the audio output to be *acoustically* coupled.²⁹

To support his position, the Examiner provides numerous references wherein *Tognazzini* provides for an audio signal. The Examiner states:

Tognazzini discloses an audio signal and a coupling device (col 3, lines 39-47, Abstract first sentence).³⁰

Also, Tognazzini further discloses processing an audio signal and a coupling device:

"A computer implemented method captures advertiser information received from an audio or video signal. The method includes the steps of receiving an incoming video or audio signal, determining whether the incoming video or audio signal includes advertisement specific data of an advertiser (Abstract)

[Claim] 1. A computer implemented method, comprising the steps of:

- (a) receiving an incoming video or audio signal;
- (b) determining whether the incoming video or audio signal includes advertisement specific data of an advertiser; ...

[Claim] 2. A computer implemented method according to claim 1, wherein said step (b) further comprises the steps of:

(bl) determining whether the incoming video or audio signal comprises an amplitude modulated (AM) signal, a frequency modulated (FM) signal or a television signal;

(b2) responsive to said step (bl), performing at least one of the following steps:

(b2- 1) determining whether the AM signal includes the advertisement specific data of the advertiser by analyzing embedded tones in low frequency component of the AM signal; ...

[Claim] 5. A computer system, comprising:

an input device detector and decoder processor, receiving an incoming video or audio signal, and determining whether the incoming video or audio signal includes advertisement specific data of an advertiser;

²⁹ The claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)

³⁰ See Examiner's Answer, mailed October 18, 2007, page 13

a data processor, operatively coupled to said input device detector and decoder processor, said data processor capturing and storing the advertiser specific data; ...

[Claim] 9. In a computer system including an input device detector and decoder processor receiving an incoming video or audio signal, and determining whether the incoming video or audio signal includes advertisement specific data of an advertiser, a data processor operatively coupled to said input device detector and decoder processor, said data processor capturing and storing the advertiser specific data, a printer or a display connected to said data processor, a computer implemented method, comprising the steps of:

(a) receiving the incoming video or audio signal;

(b) determining whether the incoming video or audio signal includes the advertisement specific data of the advertiser by performing at least one of the following steps. . . (Claim 9; col 12, line 65-col 13, line 12);

According to one design, the computer architecture includes an input device detector and decoder processor that receives an incoming video or audio signal, and determines whether the incoming video or audio signal includes advertisement specific data of an advertiser. The computer architecture also includes a data processor, operatively coupled to the input device detector and decoder processor (col3, lines 37-47);

(26) In another embodiment, a computer implemented method is provided that captures advertiser information received from an audio or video signal. The method includes the steps of

receiving an incoming video or audio signal, determining whether the incoming video or audio signal includes advertisement specific data of an advertiser, and capturing and storing the advertiser specific data (col3, line 62-col4, line 1);

(9) FIG. 2 is a detailed block diagram of the computer architecture for the computer system used to enable radio listeners and/or television viewers to obtain advertising information. In FIG. 2, input signals 14 are received by input device detector/decoder 16 of advertisement capture processor 6. Input device detector/decoder 16 then determines the type of the received signal, i.e., whether the signal is a radio AM signal, a radio FM signal or a television signal. After determining the specific type of the input signal, the input device detector/decoder 16 then analyzes the received signal for the advertising data embedded within the input signal.

(10) For example, if the input signal is a radio AM signal, input device detector/decoder 16 analyzes the AM signal for embedded tones in the low frequency range. On the other hand, if

the input signal is a radio FM signal, input device detector/decoder 16 analyzes the input signal for supra or super audible data carriers in the FM subcarrier channel. If the input signal is a television signal, device detector/decoder 16 analyzes the input signal for the vertical retrace interval for the additional data to be utilized in advertisement capture processor 6. Of course, other techniques can also be used to transmit advertising data concurrently or substantially concurrently with the video and/or audio data" (col5, lines 45-67).³¹ (emphasis original)

The Examiner concludes:

Hence, the acoustical coupling issue was priorly settled in the case history on 4/13/04. No issues have been raised regarding acoustical coupling over five subsequent office actions until this Appeal Brief. And, Tognazzini does disclose the claimed features regarding audio signals *and acoustically coupled*.³² (emphasis added)

The Examiner simply has underlined every occurrence of the words "audio," "signal," and "coupled," singularly and in combination. The underlined words provided by the Examiner do not teach an *audio output acoustically coupled* from a broadcast receiver of a broadcast source to said audio input interface for providing an audio signal as recited by the claims. The Tognazzini "audio signal," referenced by the Examiner, is not the same type of "audio signal" as claimed by the instant application. The Examiner has broken Appellants' invention into its component parts and then attempted to find a prior art reference corresponding to each component to support an obviousness rejection under 35 U.S.C. § 103. Clearly, the Examiner has fallen prey to the hindsight bias prohibited by KSR.

Tognazzini teaches receiving three signals: an AM signal, FM signal, and a TV signal. These signals, the AM, FM and TV, are *electronic carrier* signals. An electronic signal is not acoustic nor is it of the type that can be provided by an output that is acoustically coupled to an input of another device. An AM signal operates in the range of 535 Kilohertz to 1605 Kilohertz. Conversely, an acoustic audio signal, such as the type that can be heard, must operate in the range of 20 hertz to 20 Kilohertz. As such, artisans of ordinary skill in the art would know that an AM signal is not the type of audio signal that is capable of being provided by an audio output

³¹ See Examiner's Answer, mailed October 18, 2007, pages 13-16.

³² See Examiner's Answer, mailed October 18, 2007, page 16

that is acoustically coupled to an audio input, as claimed by the instant application. Additionally, *Tognazzini* contains no disclosure that the audio signal can be acoustically provided. *Tognazzini* makes no mention of any type of acoustic application.

Tognazzini does disclose the term “coupled” as cited above by the Examiner. However, what is coupled is a processor that is operatively coupled to an input device detector/decoder. The processor and the input device decoder, in *Tognazzini*, are both contained within the receiving device. Clearly, the portion that *Tognazzini* teaches is “operatively coupled” occurs after the computer system has received the signal. Independent Claim 1 of the instant application recites an audio output that is part of a broadcast source acoustically coupled to an audio input that is part of a computer. It is through the acoustic coupling that the computer receives the audio signal. *Tognazzini* contains no disclosure for a computer receiving an audio signal via an acoustic coupling to a broadcast source.

Furthermore, no explanation as to why the differences between the AM signal in *Tognazzini* and the acoustically coupled audio signal in the instant application would have been obvious to one of ordinary skill in the art has been provided. Therefore, the gap between an AM signal and an acoustically coupled audio signal is so great as to render Claim 1 of the instant application non-obvious to one of ordinary skill in the art.

The Examiner also maintains that the combination of the *Tognazzini*, *Picco* and *Harvey* renders obvious advertisement information comprising both advertising content and control content such that the advertising content can be displayed at substantially the same time that the advertisement information was received as required by Independent Claim 1 of the instant Application.³³ The Examiner states:

However, *Picco* discloses that live feeds, control information and local information can be combined in a real-time broadcast signal (Fig. 5 and below citation):

Hence, *Picco* discloses content and advertising that are live or real-time broadcast.

Additionally, *Harvey* discloses that the control information is broadcast with a live/realtime broadcast content and that the

³³ See Examiner’s Answer, mailed October 18, 2007, page 16

control information can include control information relevant to the broadcast content:

Hence, the combination of the prior art renders obvious advertising and control information which are sent in conjunction with each other such that the advertising information can be displayed at substantially the same time that the control information was received or displaying the broadcast information at substantially the same time as the control information was received.

Hence, the combination of the prior art renders obvious advertisement information comprising both advertising content and control content such that the advertising content can be displayed at substantially the same time that the advertisement information was received. (*sic*)

Hence, the combination of the prior art renders obvious the features of the Appellant's claims.³⁴ (emphasis original)

First, as previously stated, the Examiner seeks to combine prior art references that teach away from such a combination.³⁵ Specifically, the references provided by the Examiner teach away from providing advertising information that comprises both advertising content and control content wherein the control content controls the display of the advertising content “substantially at the time of reception.”

In *Tognazzini*, advertisement content is stored and displayed at a time subsequent to the reception of the advertisement content for control by a user (not by control content):

The present invention is based, in part, on the discovery or identification of the problem(s) associated in today's mobile environment. In particular, the present invention is based on the discovery that listeners and/or viewers may opportunistically *receive the advertising information and selectively store, print or display same at a later time* which is more convenient for the listener or viewer.³⁶ (*emphasis added*)

To achieve these features and advantages, the present invention provides a computer architecture used to enable radio listeners and television viewers to obtain advertising information *at*

³⁴ See Examiner's Answer, mailed October 18, 2007, pages 13-16.

³⁵ See generally Appeal Brief, filed August 3, 2007, pages 24 and 30.

³⁶ See *Tognazzini* Col 2, lines 45-51.

*a time subsequent to when such information is broadcast to the listener/viewer.*³⁷ (*emphasis added*)

This device detector/decoder 16 *then transmits the desired advertisement data to main central processing unit 18 for processing.* Main central processing unit 18 then selectively formats and outputs the advertisement data *upon the request of the user.* Main central processing unit 18 *utilizes scroll through memory 20 and advertiser memory 22* for displaying current, as well as previous, advertisements that have been received and processed by advertising capture processor 6.³⁸ (*emphasis added*)

In *Picco*, advertisement content is stored prior to a “live broadcast.” Control information in the live broadcast directs a set top box which stored advertisement content to display with the live broadcast even though other advertisement content may be broadcast with the live broadcast:

The invention may include a set-top box at a household that is capable of *storing data and inserting that stored data into live data streams*, and equipment at the data transmission facility that *assembles and delivers local content to be inserted into the live data streams at a later time* and transmits individualized instructions to each set-top box about what local content should be stored and when each piece of local content should be inserted into the live data stream.³⁹ (*emphasis added*)

Thus, the set-top box may use these coefficients to determine which pieces of local content are going to be stored by each particular set-top box and which stored pieces of local content are going to be inserted into a live feed signal by a particular set-top box.⁴⁰ (*emphasis added*)

Thus, in addition to the conventional live feeds and local content, the combiner may combine a plurality of user-specific information in the satellite signal including a private data identification code that permits the set-top box in accordance with the invention to locate the private data being transmitted through the satellite in accordance with the invention. The private data may include the compressed local content, as described above, which may be transmitted to each set-top box using several different transmission strategies, as described below. *This local content may not be transmitted in real-time in that the local content is not immediately viewed by the user of the set-top box since the set-top*

³⁷ See *Tognazzini* Col 3, lines 35-39.

³⁸ See *Tognazzini* Col 3, lines 35-39.

³⁹ See *Picco* Col 3, lines 1-9.

⁴⁰ See *Picco* Col 8, lines 7-11.

box inserts the local content into the satellite signals as needed. As described above, the private data may also include command and control data that instructs the processor within the set-top box how to insert the local content into the satellite data streams.⁴¹ (emphasis added)

Each of the private data downloading techniques have common features. First, for all of the techniques, *the local content is downloaded before insertion or viewing by the user*. Thus, the local content, in accordance with the invention, is downloaded to the set-top box in the background (i.e., un-noticed by the user) and then a particular piece of local content may be used once the entire piece of local content resides on a memory or a disk in the set-top box.⁴² *(emphasis added)*

In *Harvey*, control and datum information is transmitted in three (3) parts through a broadcast. The datum interacts with previously stored information and the control information regulates the display of the information resulting from the interaction of the datum and stored information:

Prior to a particular early time, complete local-formula-and-item information is inputted to and caused to be recorded at the computer, 73, of each controlled intermediate transmission station in such a way that each computer, 73, contains complete information relevant to the particular discounts and specials in effect at the particular markets in the vicinity of said station and at the particular time of the network transmission of Q. Thus each computer, 73, contains the specific values of a, p, q, d, Z, r, s, and dd of its specific station; the specific street address of every one of said supermarket chain's markets in the locality of said station; and other specific data of said station such as, for example, "Nabisco Zweiback Teething Toast".⁴³ (emphasis added)

Clearly, all three references provided by the Examiner teach away from an advertising information comprising advertising content and control content wherein the control content controls the display of the advertising content as substantially the same time that the advertisement information was received. When the prior art teaches away from combining certain

⁴¹ See *Picco* Col 8, lines 23-39.

⁴² See *Picco* Col 9, lines 40-48.

⁴³ See *Harvey* Col 198, lines 5-17.

elements, discovery of a successful means of combining them is more likely to be non-obvious.”⁴⁴

Regardless, the Examiner maintains that the combination of *Tognazinni*, *Picco* and *Harvey* teaches or suggests each and every limitation of Appellants claimed invention. The Examiner repeats from the Final Office Action, dated July 3, 2006:

"FIG. 5 is a block diagram of the live feeds; local content and commands being multiplexed together in accordance with the invention" (col 4, lines 25-29).

...Picco further discloses that the content that is live feed/real-time broadcast can include advertisements (Figure 1 and below citations):

"(3) FIG. 1 is a block diagram illustrating a conventional satellite-based television broadcast system 30 that includes a satellite head-end station 32 that includes an uplink antenna 34. The head-end station receives live television feeds (i.e., analog data streams) from various sources and combines those analog data streams into a single multiplexed analog signal. In this manner, an analog signal provided to the head-end station 32 may be sent to a plurality of households wherein each household may select a particular television channel to view... At the head-end station 32, the operator of the satellite-based system 30 may insert content, such as advertisements, into the satellite signal... this content is the same for all of the households that receive the satellite signal (col 4, line 65-col 5, lines 25).

Picco further discloses in Figure 3 that Live Feeds (106) and Added Content (108) can be combined at an Uplink facility and sent by satellite to a House (112). (emphasis original)

In the Examiner's Answer, dated October 18, 2007, the Examiner adds:

Notice in Figure 5 of Picco that live feeds, local content, and commands are combined and sent to the user.

...

And, Picco further discloses in Figure 4 combining Local Content (108) and Live Feeds (106) before they are sent (Multiplexer 140 and Combiner 142) to the user (114). Note in Figure 4 that the local content that is sent to the user is determined based on the scheduler and the statistical information analysis:

⁴⁴ *KSR*, 127 S. Ct at 1740.

“(9) FIG. 4 is a block diagram illustrating the uplink facility 102 (i.e., a head-end assembly) of the satellite-based television broadcast system in accordance with the invention. For reference, the satellite 104 and the set-top box 120 are also shown, but will not be described. As shown, the live television programming data feeds 106 and the local content feeds 108 are multiplexed by a multiplexer (MUX) 140 into a compressed digital data stream having a format of an MPTS. In this example, the multiplexed data stream is shown as MPTS-0, but may also be any other of the MPTS's. All of the MPTS's are then combined together using a combiner 142 and sent to a transmitter 144. The transmitter then uses the uplink antenna 110 to transmit the digital signal output from the combiner to the satellite 104 as is described.

(10) To generate a custom local content compressed data stream, as described above, the uplink facility 102 may include a database 146 that stores the local content. The local content database may store a plurality of pieces of local content such as a plurality of advertisements. Each piece of local content may also include the content profile as described below, a unique content identified code, a total time of the piece of local content, use statistics about the piece of local content, and utilization directives, such as an insert channel list, a view interval, a time of day the local content may be viewed, an expiration date of the local content or a maximum number of times a piece of local content may be viewed. The local content in the database 146 may be received from advertisers who wish to have the satellite operator include their local content (i.e., advertisements) in the television signal being transmitted by the satellite. To determine which local content is going to be combined with the live programming data feeds 106, the uplink facility may include a scheduler 148, an agent 150, and a statistical collector system 152. The scheduler may determine which local content is going to be combined by the combiner 140 with the feeds based on a variety of information. For example, data about the local content being watched at a particular household 114 may be periodically communicated to the collect and decimate system 152 in the uplink facility over a communications link 154, such as a telephone line. The data from the household may include viewing time information as well as the actual television programs being viewed. The statistical collector system may collect all of the data from every household that uses the satellite-based system and then generates statistics about the data, such as the number of users that have viewed a particular advertisement or the number of users that viewed a particular type of advertisement. The statistics generated are fed into the agent 150. The agent 150, based on the statistics, may output the statistics or use the statistics to entice new advertisers to provide

local content. The results of the agent may also be sold to outside companies, such as an advertisement agency. The agent may also be programmed to select particular local content based on the statistics. Based on the various information, the scheduler then determines the local content that is going to be transmitted by the satellite" (col 6, line 42-col 7, line 33).⁴⁵ (emphasis original)

The Examiner has simply found occurrences of the terms "advertiser," "advertisement", and references to a "live" or "real time" broadcast to illustrate a teaching for advertisement information *comprising both advertising content and control content* such that the advertising content can be displayed at *substantially the same time* that the advertisement information was received. [A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.⁴⁶ Again the Examiner has fallen prey to hindsight bias and is reading into the prior art the teachings of the invention in issue, which is prohibited by *KSR*.⁴⁷

Furthermore, the "live feeds" and "local content" in *Picco*, as shown in Figure 5 referenced by the Examiner, illustrate advertisement content (i.e., local content) that is broadcast with the live broadcast. However, this is not the same "local content" that is controlled by the control content. *Picco* explicitly states "[this] *local content may not be transmitted in real-time* in that the local content is not immediately viewed by the user of the set-top box since the set-top box inserts the local content into the satellite signals as needed." Therefore, *Picco* discloses two, separate local contents: a first local content that is stored on the set-top box; and a second local content that is broadcast with the live broadcast. It is the first local content, the local content stored on the set-top box, which is controlled by the control content. The claims of the instant application require that the advertisement content that is broadcast with the local content is the advertisement content that is displayed at substantially the same time as it was received. Further, the function of the control content in *Picco* is to determine *which* stored local content is to be inserted into the live feed. Additionally, a private data, downloaded prior to the live broadcast, may also include command and control data to instruct the system *how* to insert the stored local content. *Picco* contains no disclosure where advertising content and control content are

⁴⁵ See Examiner's Answer, mailed October 18, 2007, pages 16-17.

⁴⁶ *KSR*, 127 S. Ct. at page 1742

⁴⁷ *KSR*, 127 S. Ct. at page 1742, warning against a "temptation to read into the prior art the teachings of the invention at issue" and instructing ... to "guard against slipping into the use of hindsight."

broadcast in a broadcast program and where the control content controls a display of the advertising content at substantially the same time as the advertising content was received. Therefore, the addition of *Picco* does not cure the deficiencies of *Tognazzini*.

The Examiner has provided no explanation illustrating “why the differences between the combination of the stored advertising content of *Tognazzini*, the live feeds, control and local information of *Picco*, and the three control signals broadcast with live/real time content, and the advertising information comprising both advertisement content and control content of the instant application would have been obvious to one of ordinary skill in the art. The gap between the combination of *Tognazzini*, *Picco* and *Harvey* and Claim 1 of the instant application, i.e., the stored advertisement content inserted and manipulated by a later received control signal versus the advertisement information comprising both the advertisement content and the control content wherein the control content controls the display of the advertisement content at substantially the same time as the advertisement information was received, is so great as to render Claim 1 of the instant application non-obvious to one of ordinary skill in the art. Furthermore, the Examiner has provided no rationale to support a conclusion of obviousness.

Additionally, the Examiner maintains the obviousness rejection of the claims of the instant application, stating that the addition of *Harvey* provides for control information relevant to the broadcast content. The Examiner repeats from Final Office Action mailed July 03, 2006:

“[Claim] 37. The method of claim 21, wherein said processor processes a datum designating at least one specific channel of one of a multichannel cable and a broadcast signal, said method further comprising the step of controlling a video recorder/player to one of record and play one of video and audio contained in said at least one specific channel designated by said processed datum.

(911) In example #10, a particular program originating studio transmits the commercial of program unit Q in a network transmission and controls a plurality of intermediate transmission stations each of which controls, in turn, a plurality of subscriber stations that are ultimate receiver stations. (col 197, lines 55-60); (sic)

(801) So far this disclosure has described an intermediate transmission station that transmits conventional television programming; however, the intermediate station automating

concepts of the present invention apply to all forms of electronically transmitted programming. The station of FIG. 6 can process and transmit radio programming in the fashions of the above television programming by adding radio transmission and audio recorder/player means, each with associated radio decoder means as shown in FIG. 2B, wherever television means are shown in FIG. 6, all with similar control means to that shown in FIG. 6 and by processing radio programming with appropriately embedded signals according to the same processing and transmitting methods described above. Likewise, said station can transmit broadcast print and data communications programming by adding appropriate transmission and recorder/player means and decoder/detector means with control means and using the same processing and transmitting methods. This example has described methods at a multi-channel intermediate transmission station; the methods are also applicable in a station that transmits only a single channel of television, radio, broadcast print or data" (col 179, lines 15-39).⁴⁸ (emphasis original)

However, *Harvey* does not illustrate advertising information comprising advertising content and control content. A datum selects a specific channel. That specific channel is then either displayed or broadcast. This control signal must be received on a different channel than the advertising information, and, therefore, this information cannot be transmitted in the same signal.⁴⁹

In response the Examiner states that "the above citations from *Harvey* show that the content and control information that is broadcast can be for a single channel system. Also, *Harvey* discloses that the content and control information that is broadcast can be for content and for control information such as recording the content that is broadcast."⁵⁰ The above citations and the Examiner's emphasis in the citations that the "example has described methods at a multi-channel intermediate transmission station; the methods are also applicable in a station that transmits only a single channel of television, radio, broadcast print or data" is not applicable to Claim 37 of *Harvey*. Claim 37, of *Harvey* contains the explicit limitation "designating at least one specific channel of one of a *multichannel* cable and a broadcast signal." *Harvey* contains no disclosure that the datum is contained within that specific channel.

⁴⁸ See Examiner's Answer, mailed October 18, 2007, page 19.

⁴⁹ See Appeal Brief mailed August 7, 2007, page 34.

⁵⁰ See Examiner's Answer, mailed October 18, 2007, page 20.

The Examiner has provided no explanation why the differences in the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The function of the control signals in *Harvey* is to, first, provide information for interaction with previously stored information, then display the information resulting from that interaction, and finally to cease displaying the information resulting from that interaction. This control information does not provide for control of advertising content that is transmitted with the control information. As such, the addition of *Harvey* does not cure the deficiencies of *Tognazzini-Picco*.

Thus, each reference, *Tognazzini*, *Picco*, and *Harvey*, teaches that at least a portion of the content to be displayed during the broadcast must be stored prior to the occurrence of the broadcast. Clearly, the control content taught by *Picco* and *Harvey* require that the advertising content exist prior to transmission of the control content, whereas *Tognazzi* teaches that the user controls the display of previously stored advertiser content. Furthermore, the combination of *Tognazzini*, *Picco* and *Harvey* does not teach a computer having an audio input interface and a display; an audio output *acoustically coupled* from a broadcast receiver of a broadcast source to said audio input interface for providing an audio signal having encoded therein *advertisement information that is comprised of both advertising content and control information* and means for launching the advertising content on said display of said computer under the control of the control information *substantially at the time of reception of the advertisement information*.

The Examiner has provided references that teach individual elements of the claims of the instant application, that of advertisement content and control content. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole.”⁵¹ Further, *KSR* and the Guidelines require that the Examiner make the analysis *explicit and provide a rationale to support the conclusion of obviousness*.⁵² No such explanation has been provided. Rather, the Examiner merely states that one of ordinary skill in the art would have been motivated to combine these references in order to allow the advertiser better control of the advertisement display and in order to more

⁵¹ *Kahn*, 441 F.3d at 986, citing *Rouffett*, 149 F.3d at 1355, 1357

⁵² See *KSR*, 127 S. Ct. at page 1741 and Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of Supreme Court Decision in *KSR Int'l. Co. v. Teleflex, Inc.*” Federal Register 72 (10 Oct. 2002) 57528

effectively reach a user⁵³ and in order to better utilize broadcast and computer medium for presenting advertising information for presenting advertising or information of interest the user⁵⁴. However, the Examiner provides no support that there existed a known problem, other than that identified by the instant application, for which there was an obvious solution encompassed by the claims of the instant application.

2. Dependent Claims 2, 3, 4, 6, 12, and 14 as rejected by the combination of *Tognazzini, Picco, Harvey, and McKiel*.

The Examiner maintains that the combination of *Tognazzini, Picco, Harvey* and *McKiel* renders obvious Claims 2, 3, 4, 6, 12, and 14. The Examiner states:

Also, Examiner notes that McKiel was utilized in the rejections of 2, 3, 4, 6, 12, 14 (*sic*) to address the features of audio signals where a microphone is involved or specific types of audible tones.⁵⁵

On page 40 Appellant presents arguments in regards to McKiel. Examiner notes that the filing date of McKiel is Dec 26, 1990. And, that in 1990 McKiel already stated that it old and well known (from the Background of the Invention and Description of the Related Art section of McKiel) that control of computers with audible sounds was possible:

"(5) Voice control of various mechanical and/or electrical devices is well known in the art. In hand occupied environments or among the physically challenged, the accurate control of such devices is a much desired technology.

(6) Known control devices for electrical appliances range from simple power relays which apply or remove power from an appliance in response to the sound of a whistle or the clapping of hands, to sophisticated computer control devices which permit complex commands to be entered verbally. For example, telephone systems exist which automatically dial an outgoing telephone call in response to a verbal command identifying a desired individual" (col 1, lines 15-30).

⁵³ See Final Office Action, mailed July 3, 2006, pages 4 and 5.

⁵⁴ See Final Office Action, mailed July 3, 2006, page 7.

⁵⁵ See Examiner's Answer, mailed October 18, 2007, page 16.

Hence, the prior art rejection above utilized the further control features of McKiel that were already old and well known in 1990.⁵⁶

McKiel discloses a system for detecting vocal utterances to vary the position of a cursor on a computer. The system uses a microphone to detect repeatable sounds from a human user. The sounds of the user control the position of a cursor on a computer.⁵⁷ The Examiner has identified a reference that teaches computer responses to vocal utterances. Appellants do not dispute that, at the time the invention was made, it was known that computers could receive and respond to vocal utterances. However, *McKiel* only discloses that a microphone can be used to receive a voice or sound. *McKiel* contains no disclosure how the function of the microphone can be coupled to a broadcast source. The claims of the instant application require that the audio output be acoustically coupled

Further, the Examiner has identified no reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the invention of the instant application does. The Examiner has merely identified an element in the prior art and combined it in a manner as required Appellants' present inventive concept. [A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.⁵⁸ Again the Examiner has fallen prey to hindsight bias and is reading into the prior art the teachings of the invention in issue, which is prohibited by *KSR*.⁵⁹

⁵⁶ See Examiner's Answer, mailed October 18, 2007, page 21.

⁵⁷ See Appeal Brief mailed August 3, 2007, page 40.

⁵⁸ *KSR*, 127 S. Ct. at page 1742

⁵⁹ *KSR*, 127 S. Ct. at page 1742, warning against a "temptation to read into the prior art the teachings of the invention at issue" and instructing ... to "guard against slipping into the use of hindsight."

IV. Conclusion

In Summary, Appellants submit that the Examiner not provided an explicit analysis or rationale to support a conclusion of obviousness. Further, the Examiner has not provided an articulated reasoning to illustrate “why” one skilled in the art would combine the references in the particular manner required to provide a predictable variation. In fact, all three of the references teach away from such a combination. Instead, the Examiner simply identifies particular components for each reference, combines them in a specific manner required by Appellants’ claimed invention, and then states that it would be obvious to one skilled in the art to do so. This is clearly hindsight based reasoning that contravenes the standards imposed by the MPEP, The Examination Guidelines and the Federal Circuit, and Appellants respectfully submit that the cited combinations are improper for reasons detailed above and requests that the rejections under § 103 be withdrawn.

Respectfully submitted,

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